



Docket No.: 246134US3DIV

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/727,554
Applicants: Kuniyara HAMAZAKI
Filing Date: December 5, 2003
For: PROTECTIVE TOOL FOR THERAPEUTIC
MATERIAL DELIVERY DEVICE, CARTRIDGE FOR
THERAPEUTIC MATERIAL DELIVERY DEVICE,
AND A THERAPEUTIC MATERIAL DELIVERY
DEVICE
Group Art Unit: 3736
Examiner: VENIAMINOV, N. R.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 246134US3DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KUNIHARA HAMAZAKI : EXAMINER: VENIAMINOV, N. R.
SERIAL NO: 10/727,554 :
FILED: DECEMBER 5, 2003 : GROUP ART UNIT: 3736
FOR: PROTECTIVE TOOL FOR :
THERAPEUTIC MATERIAL DELIVERY
DEVICE, CARTRIDGE FOR
THERAPEUTIC MATERIAL DELIVERY
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MATERIAL DELIVERY DEVICE

PROVISIONAL ELECTION

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SIR:

In response to the Restriction Requirement dated December 3, 2004, Applicant provisionally elects, with traverse, the invention of Group II, Claims 4-15 as identified by the Examiner and lists Claims 4-15 as readable thereon.

Applicant traverses the outstanding Restriction requirement on the grounds that Group II is a combination including Claim 7 that recites each feature of the independent claim in Group I. While Claims 4-6 are subcombination claims just like Claims 1-3 are subcombination claims, Claims 4-6 include all the subject matter of Claims 1-3 and no grounds for restriction exist or have been set forth as to these claims. Further, no showing has been made that the subcombination features are not necessary for patentability. Accordingly, MPEP § 806.05(c)II applies, and Restriction is improper. Additionally, Applicant respectfully submits that no additional search is required.

Distinctness is defined in MPEP § 806.05(c) as follows:

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

An example a combination/subcombination where restriction is not proper is given in MPEP § 806.05(c)II:

If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the sub-combination has separate utility.

Because Claim 7 recites all the features of Claims 1-3 because of dependency (and Claim 9 includes all the features of Claims 4-6 because of dependency, with Claim 4 including all the features of Claim 1), and no showing has been made that Claim 7 is patentable without the features recited in Claims 1-3, MPEP § 806.05(c)II applies, and Claim 7 cannot be considered to be distinct from Claim 1. Similarly, Claim 9 cannot be considered to be distinct from Claim 4 or Claim 1. Therefore, Applicant respectfully urges that Claims 1-15 all be examined together.

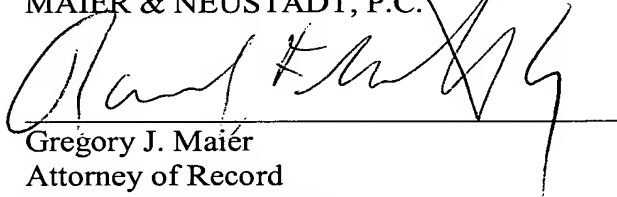
Moreover, under MPEP § 803, a Restriction is not proper if a search and examination can be made without a serious burden on the Examiner, and the outstanding Restriction requirement has not established that examining each of the currently-pending claims together would result in an undue burden. MPEP § 803 specifically states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicant respectfully submits that, as Group II as identified in the outstanding Office Action is a combination that requires the details of Group I, no separate search is needed. As the outstanding Restriction requirement has not established that each of the claims could not be examined together without an undue burden, Applicant respectfully submits that all of Claims 1-15 should be examined on the merits.

Respectfully submitted,

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